

REMARKS

The present amendment and request for reconsideration is filed in response to the Office Action mailed October 10, 2006, the period of response having been extended until April 10, 2007. Claims 20, 21, 23-29, 31, 33, 34, 36-42, 44-49, 51, 52, 54-61, 63, 65, 66, 68, 69 and 78-83 remain in this application. Claims 22, 30, 62, 70, 73, 74, 76, 77 84 and 85 have been canceled without disclaimer or prejudice. Claims 86-88 have been added.

Applicant submits that amended claims 20 and 60 are supported by the previously presented claims 20, 22 and 60, 62, respectively.

Applicant submits that new claims 86 and 87 are supported by the previously presented claims 20 and 60, respectively, and that new claim 88 is supported by the previously presented claim 20. No new matter is believed to have been added by way of these amendments.

Claim 20 stands rejected under 35 U.S.C. 103(a) as being unpatentable and obvious over Riso in view of Anani et al., likewise, claim 22 is also rejected under 35 U.S.C. 103(a) as being unpatentable and obvious over Riso in view of Anani et al. and Schulman. Applicant disagrees with these rejections in view of the aforementioned amendments as well as the following arguments.

The Riso and Anani et al. references teach a prosthetic system but they do not suggest combining the disclosed system with a microprocessor for alleviating phantom limb pain in the absence of sensory signals. The Schulman patent mentions that phantom limb pain resulting from severed limbs may be alleviated by applying stimulating pulses to the nerves proximal the damaged area. Yet Schulman does not teach a prosthetic system.

Applicant respectfully contends that the Anani and Riso references cannot be combined with the Schulman reference so as to maintain the present rejection to claim 20 as amended:

- “Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.” ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed Cir. 1984).
- MPEP §2143.01 provides that: “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” In re Mills, 916 F. 2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).
- “When patentability turns to the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied as evidence of obviousness” In re Lee, 277 F. 3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed Cir. 2002).

Applicant submits that neither Riso nor Anani et al. recognizes nor solves the problem of phantom limb pain and as such the skilled artisan would not therefore have been drawn to the Schulman patent. The Schulman patent on the other hand is not concerned with a prosthetic system but rather to an implanted heart and tissue stimulator. Schulman mentioned the alleviation of phantom limb pain in the background of the invention only and does make reference to a prosthetic limb. Therefore, it is believed that the claim as amended is not obvious as set forth in the outstanding Action.

Generally stated, Claim 20 as amended is drawn to a prosthetic system that includes a prosthetic limb and a microprocessor for avoiding phantom limb pain. The cited art neither anticipates or makes obvious what Applicant has claimed in amended claim 20.

Should claim 20 be deemed patentable over Riso and Anani et al. and Schulman as asserted by Applicant, claims 21, 23-29, 33, 34, 36-41, 78, 79 and 86 which either directly or indirectly depend from said claim should therefore also be deemed patentable.

Claim 42 is rejected under 35 U.S.C. 103(a) as being obvious and unpatentable over Riso in view of Anani et al..

Applicant submits that neither Riso nor Anani et al. recognizes or addresses the problem of phantom limb pain but rather these references are directed to the generation of stimulation in response to sensory signals from sensors in order to provide sensory feedback.

For these reasons Applicant submits that amended claim 42 is patentable over Riso and Anani et al. either individually or in combination should such combination be permissible under the Law. Claims 44-49, 51, 52, 54-59, 80 and 81 which are either directly or indirectly dependant on amended claim 42 should therefore also patentable be patentable over these references.

Claim 60 under 35 U.S.C. 103(a) as being unpatentable over Riso in view of Anani et al., and claim 62 under 35 U.S.C. 103(a) as being unpatentable over Riso in view of Anani et al. and Schulman.

As discussed and distinguished above, Applicant submits that neither Riso nor Anani et al. deal with the problem of phantom limb pain and as such the skilled artisan would not have been drawn to the Schulman patent. The Schulman patent on the other hand is not drawn to a

prosthetic system but rather to an implanted heart and tissue stimulator. Schulman mentioned the alleviation of phantom limb pain in the background of the invention only and does make reference to a prosthetic limb. Therefore, there is no teaching, motivation or suggestion to combine the Riso and Anani et al. references with the Schulman reference.

Generally stated, Claim 60 as amended is drawn to a method that includes a prosthetic limb and the step of alleviating phantom limb pain in the absence of sensory signals from the prosthetic limb. The cited art does not anticipate the foregoing and as such claim 60 is deemed patentable by Applicant. All claims dependant thereon should also be considered patentable.

Finally, Applicant submits that new claim 88 is drawn to a prosthetic limb which includes among other elements a microprocessor which provides for alleviating phantom limb. Such a prosthetic limb is not taught in the cited art, hence claim 88 is deemed patentable by Applicant.

Favorable reconsideration of the present application and early issuance of the Notice of Allowance are earnestly solicited.

Respectfully submitted,

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By: 
Timothy J. Keefer, Reg. No. 35,567

SEYFARTH SHAW LLP
131 S. Dearborn Street
Suite 2400
Chicago, Illinois 60603-5577
Telephone: (312) 460-5000
Facsimile: (312) 460-7000

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I hereby certify that this paper is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, Mail Stop: Amendment.

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Deborah E. Dudek
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